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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,563	04/25/2001	Mika Juhani Gronroos	297-010153-US(PAR)	7497

7590 06/04/2004
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EXAMINER

CHIANG, JACK

ART UNIT	PAPER NUMBER
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2642

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DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842563

Applicant(s)

Gronroot

Examiner

J. Chiang

Group Art Unit

2642

710

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE - 3 - MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3-15-04.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-33 is/are pending in the application.
- Of the above claim(s) 6-27, 30-32 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-5, 28-29, 33 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

RESTRICTION

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Specie 1: claims 2-5, 28-29, 33 related to a releasing actuator(s);

Specie 2, claims 6-12, conductor and connector;

Specie 3, claim 13, torsion spring;

Specie 4, claim 14, spiral spring;

Specie 5, claims 15-25, a damper arrangement;

Specie 6, claim 26, an electric motor;

Specie 7, claim 27, a pair of magnets;

Specie 8, claim 30, a display;

Specie 9, claim 31, an antenna;

Specie 10, claim 32, a loudspeaker.

2. The amendment dated on 03-15-04 created additional species. A new grouping has been shown above. An election was made by applicant in paper dated on 10-14-03. Claims 1-5, 28-29 and 33 are examined. Claims 6-27, 30-32 are considered as non-elected claims, and have been withdrawn from further consideration. This restriction is made final. (See also the restriction dated on 09-09-03).

DRAWINGS

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “two release actuators ... synchronized... unsynchronized” called for in claims 3-5 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

CLAIMS

112-First Paragraph Rejection

4. Claims 4-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See comments below.

Claims 4-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 4 claims "two release mechanisms are synchronized so that actuating either one of them alone..."; and

Claim 5 claims "two release mechanisms are unsynchronized so that only actuating both of them simultaneously...".

There is no such description in the original disclosure about actuating either one of the buttons alone is considered as "synchronized", nor for the "unsynchronized". Therefore, it is considered as unenabling and a new matter.

(NOTE: applicant stated that Figs. 6c and 6d were submitted with this amendment, however, there is none submitted with the current amendment. Further, if Figs. 6c and 6d were meant to show these "synchronized" and "unsynchronized" features, then these figures should have detail design on how these "synchronized" and "unsynchronized" features are achieved. Further, any detail design should be supported by the original disclosure).

Art Rejection

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Castiel (US 6249672).

Regarding claim 1, Castiel shows:

A body part (104) constructed to house a portion (i.e. 120) of a telephone apparatus;

A sleeve-like grip part (102) adapted to be held by a user during use and constructed to receive the body part (104, see fig. 3) for longitudinal slidable movement of the body part (104) on the grip part (102), between a retracted position (fig. 3) and an extended position (fig. 1a);

An actuator mechanism (the slide, see col. 2, lines 6-15) coupled between the grip part (102) and the body part (104) for effecting the longitudinal slidable movement of the body part (104) relative to the grip part (102) between the retracted position (fig. 3) and the extended position (fig. 1a);

A locking mechanism (400) for detachably locking the body part (104) into the grip part (102) in the retracted position (fig. 3);

A user-actuatable releasing actuator (106) mounted in the grip part (102) for releasing the locking mechanism (400, col. 2, lines 13-15).

Regarding claims 2 and 28, Castiel shows:

The grip part (102) having first and second side surfaces (two sides), and the actuator (106);

The body part (104) having a majority of the electrical parts, and the grip part (102) having surfaces configured for a single-hand grip.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-5, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Castiel in view of Holmberg (US 6568956).

Regarding claims 3-5, Castiel shows the release actuator (106).

Castiel differs from the claimed invention in that it shows one release actuator instead of two.

However, the concept of providing a release actuator is well taught by Castiel. Further, Holmberg teaches providing two release actuators (12) for a locking mechanism. Also, from the pages 8 and 12 of the present application, it shows one release actuator and suggests that two release actuators can be used. In other words, there is no details on how two actuators can be implemented, and no teaching of criticality for one actuator over two actuators.

Hence, it would have been obvious for one skilled in the art to use Castiel as it is, or to modify Castiel with two actuators as taught by Holmberg. This simply can be considered as a variation of Castiel as long as the basic concept of providing the release actuator is substantially unchanged. This also can be considered as duplicating

parts of the Castiel's device (St. Regis Paper Co. v Bemis Co., 193 USPQ 8, 7th Cir. 1977).

9. Claims 29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castiel in view of Gray (US 5440629).

Regarding claims 29 and 33, Castiel shows the body part (104) and the grip part (102) (see comments in claim 1).

Castiel differs from the claimed invention is the positions of the body part and the grip part. In Castiel, the body part is on the lower position, and the grip part is on the upper position, and the positions for these two elements are reversed in the claimed invention. However, Gray teaches providing both the claimed invention and the Castiel invention. In Gray, it shows a body part (12). It further shows a sleeve-like grip part which can be on the upper position (such as 48), this is similar to Castiel; another sleeve-like grip part which can be on the lower position (such as 50), this is similar to the claimed invention.

Therefore, it would have been obvious for one of ordinary skill in the art to use Castiel as it is, or to modify Castiel by providing the sleeve-like grip part on the lower position with the teaching of Gray. This simply can be considered as a variation of Castiel because the basic concept of providing the sleeve-like grip part and the body part, and their sliding operation, is substantially unchanged. In fact, if a user turns Castiel's phone up side down, then the sleeve-like grip part would face downward, and there is no difference in the sliding mechanism and its operation.

ARGUMENT

10. In response to the remarks (pages 6-9), in pages 6-7, applicant first argues about the reception difficulties and the impedance of the antenna in the Castiel reference.

The examiner disagrees. Applicant's argument and his asserted problem are not found in the Castiel reference. In fact, today's cell phones are all substantially palm size, if Castiel has such problem, then it is expected that applicant's phone would have a similar problem.

In page 7, second paragraph, applicant first argues that "there is no sleeve-like grip part described in the reference Castiel". The examiner disagrees. First, if applicant meant that there is no "sleeve-like", then applicant is directed to Castiel's fig. 3.

Second, if applicant meant that there is no "grip part", then applicant's own statement, "Judging from ... figure 3, it would appear that it is module 102 that is intended to be held...", is an answer to applicant's argument. Third, putting these terms together would create "sleeve-like grip part", and if applicant still argues that "there is no sleeve-like grip part described in the reference Castiel", then the examiner properly have no idea what the applicant is arguing about.

In page 7, second paragraph, applicant further argues that "... Castiel ... two body modules neither of which is specifically designed with grasping in mind". The examiner disagrees. First, this is a cell phone which is meant to be grasped by a user's hand. Second, again, applicant's own statement, "Judging from ... figure 3, it would appear that it is module 102 that is intended to be held...", is an answer to applicant's argument.

In page 7, second paragraph, applicant further argues that “the grip part ... does not house any of the main electronics, but is constructed primarily to provide a grip ... This is significantly different than either of ... 102 and 104 of Castiel”. The examiner disagrees. Applicant’s grip part does house electronics, such as connector and microphone (1001, 1002). It is not seen it is different from elements 102 and 104 of Castiel.

In page 7, about Holmberg, it is used to show other features in the claims, see rejection above.

In pages 7-8, applicant talks about “The Issue of Anticipation”, and pull out a portion of the claim to support his argument. This issue, including claim 1, has been discussed above, see comments and rejections above.

In conclusion, the claimed invention is anticipated by the cited reference(s).

11. Applicant’s arguments with respect to claims 1-5, 28-29 and 33 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

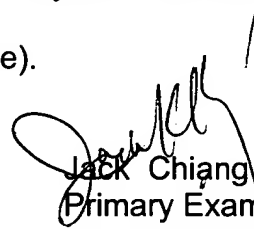
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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Primary Examiner
Art Unit 2642